

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Johnny B. Corvin

Application No.: 09/775,115

Confirmation No.: 8786

Filed: February 1, 2001

Art Unit: 2424

For: METHODS AND SYSTEMS FOR FORCED
ADVERTISING

Examiner: J. E. Shepard

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

PETITION UNDER 37 C.F.R. § 1.181(a)
TO WITHDRAW HOLDING OF ABANDONMENT

Sir:

Applicants hereby petition under 37 C.F.R. § 1.181(a) to withdraw the holding of Abandonment set forth in the Notice of Abandonment mailed on May 12, 2009 (Exhibit A). Pursuant to 37 C.F.R. § 1.181(f) and MPEP § 711.03(c)(I)(C), this Petition is being timely filed within two months of the mailing date of the Notice of Abandonment (i.e., on or before July 12, 2009).

Introduction

On January 25, 2008, the USPTO mailed a Final Office Action (Exhibit B.)

On July 23, 2008, applicants filed a Pre-Appeal Request for Review (Exhibit C) and a Notice of Appeal (Exhibit D) in response to the Office Action. The listing of the documents located in the image file wrapper on Private PAIR for this application indicates that the Notice of Appeal was received by the USPTO on July 25, 2008.

On December 9, 2008, the USPTO mailed a Notice of Panel Decision from Pre-Appeal Brief Review ("Notice of Panel Decision"). (Exhibit E.)

On May 12, 2009, the USPTO mailed a Notice of Abandonment alleging that applicants had failed to file a timely reply to the Office Action mailed January 25, 2008.

Petition under 37 C.F.R. § 1.181(a) to Withdraw Holding of Abandonment

The Notice of Panel Decision states that "the time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable."

The one-month date from the mailing of the Notice of Panel Decision is January 9, 2009, while the two-month date from the receipt of the notice of appeal is September 23, 2008. Accordingly, upon receipt of the Notice of Panel Decision, the time period for filing an appeal brief was reset to be January 9, 2009 (i.e., the greater of the two dates), which due date is extendible under 37 CFR 1.136 for an additional five months (i.e., until June 9, 2009).

Therefore, the holding of abandonment is improper at least because the Notice of Abandonment was mailed prior to the expiration of the period for filing a timely Appeal Brief, and should be withdrawn.

Conclusion

Based on the foregoing, applicants respectfully request that the USPTO grant this Petition to withdraw the holding of abandonment. Pursuant to MPEP § 711.03(c)(I)(B), no fee is due in connection with this Petition. However, the Director is hereby authorized to charge any fees that may be due, or credit any overpayment of the same, to Deposit Account No. 06-1075 (Order No. 003597-0179).

Dated: June 9, 2009

Respectfully submitted,

/Regina Sam/

Regina Sam
Limited Recognition No. L0381
Customer No. 75563
Ropes & Gray LLP
Attorneys/Agents for Applicants



UNITED STATES PATENT AND TRADEMARK OFFICE

Exhibit A

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/775,115

02/01/2001

Johnny B. Corvin

UV-179

8786

75563 7590 05/12/2009

ROPES & GRAY LLP
PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8704

EXAMINER

SHEPARD, JUSTIN E

ART UNIT

PAPER NUMBER

2424

MAIL DATE

DELIVERY MODE

05/12/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of Abandonment	Application No.	Applicant(s)	
	09/775,115	CORVIN, JOHNNY B.	
	Examiner	Art Unit	
	Justin E. Shepard	2424	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 25 January 2008.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☒ A reply was received on 25 July 2008 but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) ☐ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☒ The reason(s) below:

A notice of appeal was filed, but no brief has been filed within the required time period.

/Christopher Kelley/
Supervisory Patent Examiner, Art Unit 2424

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.



Best Available Copy

Exhibit B

US

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/775,115

02/01/2001

Johnny B. Corvin

UV-179

8786

75563

7590

01/25/2008

ROPES & GRAY LLP

PATENT DOCKETING 39/361

1211 AVENUE OF THE AMERICAS

NEW YORK, NY 10036-8704

EXAMINER

SHEPARD, JUSTIN E

ART UNIT

PAPER NUMBER

2623

MAIL DATE

DELIVERY MODE

01/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/775,115	CORVIN, JOHNNY B.	
	Examiner	Art Unit	
	Justin E. Shepard	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-16, 40-48 and 69-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-16, 40-48 and 69-80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 12/18/07 have been fully considered but they are not persuasive.

Page 3, paragraph beginning with "First, the Examiner":

The applicant argues that Mori teaches a "CD reproduction device" that cannot be combined with the forced advertisement system disclosed by Zigmond. As Mori teaches a device for playing video-cds (see machine translation) that can resume playback after a loss of power, and Zigmond discloses a device for playing back advertisement from a storage device (column 10, lines 16-35), the combination of these references is valid as the storage medium from Zigmond could easily be a video-cd.

Page 4, section A:

The applicant argues that Aoyama could not be combined with Zigmond. As the rejection is formed such that Aoyama is being used to modify Mori and not directly modifying Zigmond, this argument is moot.

Page 4, section B:

The applicant argues that Aoyama cannot be combined with Mori. As Mori describes a device to reproduce a piece of media after a power outage, and Aoyama teaches a device that reproduces a piece of media (or advertisement) after an interruption (playing of a karaoke song); it would make sense to combine the

references, as Aoyama teaches that a commercial is usually short so that it loses all meaning if the viewer only views a portion of it, so there is motivation to combine.

Page 5, section C:

The applicant argues that the combination of Zigmond, Mori, and Aoyama would not result in the claimed invention. As Zigmond discloses a device to force users to view an advertisement that has been stored locally on the device, and Mori teaches a system for resuming video after a power failure such as a commercial, and finally Aoyama teaches replaying an advertisement after an interruption (such as the playing of a song). There way the examiner is interpreting the references, the combination would result in the claimed invention.

Page 7, paragraph beginning with "As set forth":

The applicant argues that the combination of Zigmond and Russo would result in the destruction of the Zigmond reference. As Zigmond discloses a system wherein targeted ads are sent and stored on the user's set top box, wherein Russo teaches a PPV system wherein user selected videos are stored on the user's set top box. In a way, a targeted ad is like a user selected video, and storing the place where it was interrupted for replaying at another time is common to both references, but using different methods. Therefore modifying the Zigmond reference with the teachings of Russo is a valid combination.

Page 8, section IV:

The examiner has included machine translations of the two references in question. Upon browsing the references, the translations back up the interpretations of the abstracts by the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 14, 16 and 40, 42, 43, 45, 46, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of Mori in view of Aoyama.

Referring to claim 14, Zigmond discloses a method of presenting a forced advertisement to a television viewer, the method comprising:

detecting the forced advertisement in an incoming video stream;
presenting the forced advertisement on user equipment (column 7, lines 2-32).

Zigmond does not disclose a method with the step of turning off the user equipment while the forced advertisement is being displayed; and automatically presenting the forced advertisement, when the user equipment is turned on, from the beginning of the forced advertisement.

In an analogous art, Mori teaches a method with the step of turning off the user equipment while the forced advertisement is being displayed; and automatically

presenting the forced advertisement, when the user equipment is turned on (Abstract: Solution; Note: as the ads disclosed by Zigmond are downloaded onto the STB (figure 6, part 106), the device taught by Mori is considered to be analogous art as it deals with resuming playback of data from a storage medium after a power failure).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the resuming after a power loss taught by Mori to the system disclosed by Zigmond. The motivation would have been to enable the device to present an entire program even after a power loss had occurred, therefore allowing the broadcaster to guarantee that an ad would be played on the STB regardless of the user's actions.

Zigmond and More do not disclose a method wherein the ad is played from the beginning of the forced advertisement.

In an analogous art, Aoyama teaches a method wherein the ad is played from the beginning of the forced advertisement (Abstract: Solution).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the replay from the beginning method taught by Aoyama to the method disclosed by Zigmond and Mori. The motivation would have been that playing an advertisement in its entirety would allow for better viewer retention over showing only the last few seconds.

Claims 40, 43, and 46 are rejected on the same grounds as claim 14.

Referring to claim 16, Zigmond discloses a method of claim 14, wherein the forced advertisement is stored in the user equipment (figure 6, part 106).

Claims 42, 45, and 48 are rejected on the same grounds as claim 16.

2. Claims 15, 41, 44, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of Mori in view of Aoyama as applied to the claims above, and further in view of Hite.

Referring to claim 14, Zigmond, Mori and Aoyama do not disclose a method of claim 14, further comprising preventing the television viewer from changing channels while the forced advertisement is being presented.

In an analogous art, Hite teaches a method of claim 14, further comprising preventing the television viewer from changing channels while the forced advertisement is being presented (column 11, lines 58-60).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the channel changing suppression taught by Hite to the method disclosed by Zigmond, Mori and Aoyama. The motivation would have been to stop aggressive channel surfers from avoiding the commercials (Zigmond: column 13, lines 16-39).

Claims 41, 44, and 47 are rejected on the same grounds as claim 15.

3. Claims 69, 71, 72, 74, 75, 77, 78, and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of Russo in view of Mori.

Referring to claim 69, Zigmond discloses a method of presenting a forced advertisement, the method comprising: detecting the forced advertisement in an

incoming video stream; presenting the forced advertisement on user equipment (column 7, lines 2-32).

Zigmond does not disclose a method with the steps of turning off the user equipment while the forced advertisement is being displayed; and automatically presenting the forced advertisement, when the user equipment is turned on, from the point at which the user equipment was turned off.

In an analogous art, Russo teaches a method with the steps of interrupting the user equipment while the forced advertisement is being displayed; and automatically presenting the forced advertisement, when the user equipment is uninterrupted, from the point at which the user equipment was interrupted (column 5, lines 14-19).

At the time of the invention it would have been obvious for one of ordinary skill in the art to use the video resuming taught by Russo in the system disclosed by Zigmond. The motivation would have been to allow the user to have the ability to watch a program or commercial from the point when their watching was interrupted from a network outage, thereby allowing for the advertiser to be assured that their advertisement was aired.

Zigmond and Russo do not disclose a system where the interruption is caused by a power loss.

Mori discloses a system where the interruption is caused by a power loss (Abstract: Solution).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the resuming after a power loss taught by Mori to the system disclosed by

Zigmond. The motivation would have been to enable the device to present an entire program even after a power loss had occurred, therefore allowing the broadcaster to guarantee that an ad would be played on the STB regardless of the user's actions.

Claims 72, 75, and 78 are rejected on the same grounds as claim 69.

Claims 71, 74, 77, and 80 are rejected on the same grounds as claim 16.

4. Claims 70, 73, 76, and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of Russo in view of Mori as applied to the claims above, and further in view of Hite.

Referring to claim 70, Zigmond, Russo and Mori do not disclose a method of claim 69, further comprising preventing the television viewer from changing channels while the forced advertisement is being presented.

In an analogous art, Hite teaches a method of claim 69, further comprising preventing the television viewer from changing channels while the forced advertisement is being presented (column 11, lines 58-60).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the channel changing suppression taught by Hite to the method disclosed by Zigmond, Mori and Aoyama. The motivation would have been to stop aggressive channel surfers from avoiding the commercials (Zigmond: column 13, lines 16-39).

Claims 73, 76, and 79 are rejected on the same grounds as claim 70.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin E. Shepard whose telephone number is (571) 272-5967. The examiner can normally be reached on 7:30-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2623

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JS


CHRIS KELLEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through 06/30/2008. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) UV-179	
	Application Number 09/775,115	Filed February 1, 2001	
	First Named Inventor Johnny B. Corvin		
	Art Unit 2623	Examiner J. E. Shepard	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input type="checkbox"/> attorney or agent of record. Registration number _____</p> <p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. <u>L0381</u></p> <p><i>Regina Sam</i> _____ Signature</p> <p>Regina Sam _____ Typed or printed name</p> <p>(617) 951-7814 _____ Telephone number</p> <p>July 23, 2008 _____ Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			

<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: MS AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.	
Dated: <u>7-23-08</u>	Signature: <i>Mary Murphy</i> (Mary Murphy)



Hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to:
MS AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: 7-23-08

Signature: Mary Murphy
(Mary Murphy)

Docket No.: UV-179
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Johnny B. Corvin

Application No.: 09/775,115

Confirmation No.: 8786

Filed: February 1, 2001

Art Unit: 2623

For: METHODS AND SYSTEMS FOR FORCED
ADVERTISING

Examiner: J. E. Shepard

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

INTRODUCTORY COMMENTS

Pursuant to 1296 Off. Gaz. 2 (July 12, 2005), applicant requests review of the final rejection of claims 14-16, 40-48, and 69-80 in the above-identified application. No amendments are being filed with this Request. This Request is being filed with a Notice of Appeal.

REMARKS

Introduction

Claims 14-16, 40-48, and 69-80 are pending in this application. In the Final Office Action mailed January 25, 2008, claims 14, 16, 40, 42, 43, 45, 46, and 48 were finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Zigmond et al. U.S. Patent No. 6,698,020 ("Zigmond") in view of Mori Japanese Patent No. 410162484A ("Mori") and Aoyama Japanese Patent No. 408076778A ("Aoyama"). Claims 15, 41, 44, and 47 were finally rejected under 35 U.S.C. § 103(a)

as being unpatentable over Zigmond in view of Mori, Aoyama, and Hite et al. U.S. Patent No. 6,002,393 ("Hite"). Claims 69, 71, 72, 74, 75, 77, 78, and 80 were finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Zigmond in view of Mori and Russo et al. U.S. Patent No. 5,619,247 ("Russo"). Finally, claims 70, 73, 76, and 79 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zigmond in view of Russo, Mori, and Hite.

For the purposes of this Request, applicant will specify the omission of essential elements required to make a *prima facie* rejection of claims under 35 U.S.C. § 103(a). In particular, applicant will show that the alleged combination does not produce the claimed invention and further that there is no motivation to modify Zigmond in the manner suggested by the Examiner. Applicant reserves the right to present additional arguments upon the decision of the panel review.

The § 103 Rejections of the Independent Claims

Each of independent claims 14, 40, 43, 46, 69, 72, 75, and 78 is directed to presenting a forced advertisement on user equipment. The forced advertisement is detected in an incoming video stream and presented on the user equipment. The user equipment is turned off while the forced advertisement is being presented. When the user equipment is turned on, the forced advertisement is automatically presented from the beginning of the forced advertisement (claims 14, 40, 43, and 46) or recommenced from the point at which the user equipment was turned off (claims 69, 72, 75, and 78).

Zigmond describes selecting and inserting advertisements into a video programming feed. As shown in FIG. 6 of Zigmond, a home entertainment system "receives video programming from a content provider and displays the video programming." (Col. 17, ll. 21-23.) A stored advertisement is selected and an "ad insertion device *waits for a triggering event that indicates an appropriate time to insert the selected advertisement.*" (Col. 17, ll. 23-28, emphasis added.) The triggering event is "a designated signal encoded in video programming feed" or may be implied by "the conventional pattern of advertisements in [the] video programming feed." (Col. 8, ll. 39-45.) To address advertisement avoidance by so-called "aggressive channel surfers," Zigmond proposes that a video switch "inserts one particular advertisement into each advertisement slot that the channel

surfer encounters as he or she progresses through the channel lineup” so that “the channel surfer is repeatedly exposed to at least bits and pieces of the one particular advertisement.” (Col. 13, ll. 20-26, emphasis added.) Alternatively, “the video programming broadcast ... is coordinated so that each channel simultaneously broadcasts advertisement slots” and “a selected advertisement is displayed simultaneously on all of the multiple channels.” (Col. 13, ll. 29-35.)

Mori describes a "CD reproducing device" which is able to resume reproducing from a "reproducing interrupted spot" without any time delay when a power source is switched ON again after the power source is switched OFF (Mori, Abstract). Mori does not mention using the system for advertisements.

The Examiner concedes that Zigmond does not teach resuming an interrupted advertisement from the beginning or from the point of interruption when the user equipment is turned off and then back on. However, the Examiner contends that Zigmond may be modified according to Mori to add this resuming feature for advertisements. (See Office Action, pp. 4 and 5). Applicant disagrees.

First, the combination of Zigmond and Mori (with either Aoyama or Russo) would not produce the claimed invention. Zigmond repeatedly states that a video programming feed received from a content provider may be interrupted to display a stored advertisement only at "an appropriate time" indicated by specific "triggering events." See, e.g., Col. 17, ll. 23-28 ("the ad insertion device waits for a triggering event that indicates an appropriate time to insert the selected advertisement"); Col. 7, ll. 25-32 ("At an appropriate time specified by encoded data in video programming feed 52 or by the structure of video programming feed 52, the household advertisement insertion device 60 interrupts the display of the video programming feed 52 [and an] ... advertisement 59 ... is then displayed to the viewer"); Abstract ("the advertisement insertion device monitors the programming feed for a triggering event indicating an appropriate time to display the selected advertisement."). A common thread through Zigmond is the strategic insertion of advertisements into the programming feed so that advertisements are displayed only in "advertisement slots" determined by the content provider and indicated by a triggering event carried in the video programming feed originating from the content provider. Even in the discussion of "aggressive channel surfers," advertisements are displayed to a channel surfer only if the surfer "encounters" a pre-scheduled "advertisement slot"

while progressing through the channel lineup. At no point does Zigmond teach or suggest that the video programming feed may be interrupted to display an advertisement simply because a viewer chose to change channels or, in this case, previously turned off the user equipment while the advertisement was being displayed.

Mori, which includes a content resuming feature, fails to make up for this deficiency. Mori is completely silent about resuming playback of advertisements. Because programming content in Zigmond is carried in a video programming feed that is received from a content provider and displayed by the home entertainment system, the combination with Mori would at best result in a home entertainment system with the capability to display both content received from a content provider and that stored on a CD, with the CD content being resumed if interrupted by a power down. Nothing in either Zigmond or Mori suggests any coordination between the CD and video feed so that advertisements triggered by the video feed will be resumed using the CD playback feature if interrupted by a power down. Moreover, because CDs generally contain content that a viewer wants to watch (as evidenced by their willingness to voluntarily obtain and insert the CD into a CD player), it may be obvious to try to resume interrupted content on a CD. However, the Examiner provides no rational reason for why a content provider would store advertisements for a video programming feed on a CD, when the programming content is itself displayed upon receipt from the content provider.

Aoyama and Russo are relied on for their purported teachings regarding whether the advertisement is resumed from the beginning or from the point of interruption. Both completely silent regarding the behavior of the system in Zigmond if an advertisement is interrupted by turning off the user equipment on which it is being displayed.

Second, even if the alleged combination would produce the claimed invention, which it would not, there is no motivation to modify Zigmond in the manner suggested by the Examiner. While the Supreme Court, in KSR Int'l Co. v. Teleflex, Inc., 127 S.Ct. 1727 (2007) ("KSR"), determined that the teaching, suggestion, or motivation ("TSM") test cannot be applied rigidly, the Court acknowledged that the TSM test captures a helpful insight and is one of a number of valid rationales that could be used to determine obviousness (KSR, 127 S.Ct. at 1737). "The key to

supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." (MPEP 2143) The Examiner here provides no rational basis outside of applicant's disclosure to suggest why one skilled in the art would modify Zigmond to go against its basis tenets and trigger advertisements based on local user actions rather than a triggering event determined by the content provider. Rather, with the knowledge of applicants' novel systems and methods for presenting forced advertisement, the Examiner identified and isolated particular features of Mori and Aoyama for use in combination with Zigmond to reject applicant's invention, without providing the requisite evidence for combining these references. In doing so, the Examiner has simply taken applicants' disclosure as a blueprint for piecing together these references, thereby demonstrating mere hindsight reconstruction, which is the very syndrome that the requirement for objective evidence is designed to combat. See In re Dembiczak, 50 USPQ2d 1614 (Fed. Cir. 1999).

Conclusion

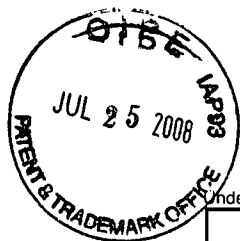
For at least the above reasons, applicant submits that requirements for establishing a prima facie case of obviousness have not been met to support the rejection of independent claims 14, 40, 43, 46, 69, 72, 75, and 78 under 35 U.S.C. § 103(a). The dependent claims are also not obvious for at least the same reason. Accordingly, applicant respectfully requests that the panel issue a written decision withdrawing the rejection of the claims.

Applicant believes no fee is due with this response, other than what is reflected on the enclosed Fee Transmittal. However, if an additional fee is due, please charge our Deposit Account No. 06-1075, under Order No. 003597-0179 from which the undersigned is authorized to draw.

Dated: July 23, 2008

Respectfully submitted,

By Regina Sam
Regina Sam (Limited Recognition No: L0381)
ROPES & GRAY LLP
Customer No. 75563
Attorneys/Agents For Applicant



PTO/SB/31 (01-08)

Approved for use through 06/30/2008. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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NOTICE OF APPEAL FROM THE EXAMINER TO THE BOARD OF PATENT APPEALS AND INTERFERENCES		Docket Number (Optional) UV-179
In re Application of Johnny B. Corvin		
Application Number 09/775,115		Filed February 1, 2001
For METHODS AND SYSTEMS FOR FORCED ADVERTISING		
Art Unit 2623		Examiner J. E. Shepard

Applicant hereby **appeals** to the Board of Patent Appeals and Interferences from the last decision of the examiner.

The fee for this Notice of Appeal is (37 CFR 41.20(b)(1)) \$ 510.00

☐ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is: \$ _____

☐ A check in the amount of the fee is enclosed.

☐ Payment by credit card. Form PTO-2038 is attached.

☒ The Director has already been authorized to charge fees in this application to a Deposit Account. I have enclosed a duplicate copy of this sheet.

☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 06-1075. I have enclosed a duplicate copy of this sheet.

☒ A petition for an extension of time under 37 CFR 1.136(a) (PTO/SB/22) is enclosed.

WARNING: INFORMATION ON THIS FORM MAY BECOME PUBLIC. CREDIT CARD INFORMATION SHOULD NOT BE INCLUDED ON THIS FORM. PROVIDE CREDIT CARD INFORMATION AND AUTHORIZATION ON PTO-2038.

I am the

☐ applicant /inventor. Regina Sam
Signature

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) Regina Sam
Typed or printed name

☐ attorney or agent of record.
Registration number _____ (617) 951-7814
Telephone number

☒ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34. L0381 July 23, 2008
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: MS AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: 7-23-08Signature: Mary Murphy (Mary Murphy)



UNITED STATES PATENT AND TRADEMARK OFFICE

Exhibit E

UNITED STATES DEPARTMENT OF COMMERCE
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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/775,115

02/01/2001

Johnny B. Corvin

UV-179

8786

75563 7590 12/09/2008

ROPES & GRAY LLP
PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8704

EXAMINER

SHEPARD, JUSTIN E

ART UNIT

PAPER NUMBER

2424

MAIL DATE

DELIVERY MODE

12/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of Panel Decision from Pre-Appeal Brief Review	Application/Control No.	Applicant(s)/Patent under Reexamination	
	09/775,115	CORVIN, JOHNNY B.	
	CHRISTOPHER KELLEY	Art Unit 2424	

This is in response to the Pre-Appeal Brief Request for Review filed 25 July 2008.

1. ☐ **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

- ☐ The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
- ☐ The request does not include reasons why a review is appropriate.
- ☐ A proposed amendment is included with the Pre-Appeal Brief request.
- ☐ Other: .

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. ☒ **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

☒ The panel has determined the status of the claim(s) is as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: *all*.

Claim(s) withdrawn from consideration: _____.

3. ☐ **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4. ☐ **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

(1) CHRISTOPHER KELLEY.

(3) Justin Shepard.

(2) Chris Grant.

(4) _____.

/Chris Kelley/
Supervisory Patent Examiner, Art
Unit 2424

/Christopher Grant/
Supervisory Patent Examiner, Art
Unit 2423